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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,335	01/19/2001	Mark A. Stevens	2000.034/1109.007	7723
30636 7590 10/15/2007 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			EXAMINER HUYNH, CONG LAC T	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/766,335

Applicant(s)

STEVENS, MARK A.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-20 and 22-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-20, 22-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/6/07 to the application filed on 1/19/01.
2. Claims 2-3, and 21 are canceled.
3. Claims 1, 4-20, 22-38 are pending in the case. Claims 1, 20, 34-38 are independent claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 38 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 1 and 38, the claims are directed to a translator for translating a source file to a target file. The translator, which is merely a functional descriptive material, without being embodied in a computer readable medium is not statutory since the function of the descriptive material is not realized. See MPEP 2106

(..When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized..)

The claims, though amended to include an output module to output the target file, are merely functional descriptive material.

It is suggested to add "embodied in a computer readable storage medium" after "A translator" (line 1) the preambles of the claims to overcome the 101 issue.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-20, 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grobler et al. (US Pat App Pub No 2002/0052893 A1, 5/2/02, filed 12/13/00) in view of Gemma (US 4,910,704, 3/20/90).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 4-20, 22-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Grobler et al. (US 2002/0052893, 5/2/02, filed 12/13/00).

Regarding independent claim 20, Grobber discloses:

- identifying a feature set of a source file ([0062]-[0067], [0018]-[0021]: identify the tags of a table in the source file where said tags, which is a set of tags, represent the table feature)
- storing and analyzing the feature set in a buffer (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- assembling the feature set in a buffer ([0067]-[0069], [0071]: analyzing the tags in the source table data and selecting only tags suitable for creating a target table to import to the target file show assembling the feature set in a buffer where data is temporarily stored)
- writing the feature set into a target file in the target format (figure 7, [0068]-[0073], [0021]: writing the source table into the target table in the target file by converting the source table tags into the target table tags)

Regarding claim 22, which is dependent on claim 20, Grobber discloses that features of the feature set are selected from the group consisting of paragraph style, straddled cells in a table, cross-referencing, pen styles in a drawing, other document formatting, document header specification, document footer specifications, discontinuity indicator, order indicators, location indicators, beginning indicators, ending indicators, data types, data translation pairs, document macros, implied features, implied feature endings, and

Art Unit: 2178

combination thereof ([0061]: the beginning indicators and the ending indicators of the table tags are selected).

Regarding claim 23, which is dependent on claim 20, Grobber discloses mapping code fragments of the source file to a feature list ([0045], [0048]).

Regarding claim 24, which is dependent on claim 23, Grobber discloses looking up the code fragments in a front-end lookup table ([0048]-[0052]).

Regarding claim 25, which is dependent on claim 24, Grobber discloses permitting the front-end lookup table to be user modifiable ([0053], [0069]).

Regarding claim 26, which is dependent on claim 20, Grobber discloses mapping the feature set to code fragments of the target file ([0049]-[0050], [0057]-[0058]).

Regarding claim 27, which is dependent on claim 26, Grobber discloses looking up the feature set in a back-end lookup table (figures 4-5, [0050]-[0051]: making selections regarding the format of the individual columns selected for the target table implies a provided list or table for looking up the table tags before selecting).

Regarding claims 28 and 29, which are dependent on claim 20, Grobber discloses identifying a feature set of a plurality of source files having a plurality of source formats

Art Unit: 2178

writing the feature set into a plurality of target files having a plurality of target formats ([0023]: the fact that the data transformation from a source file to a target file can be applied to a *plurality of documents at the same time* implies that said data can be identified in a plurality of source files having different formats and written to a plurality of target files having of course a plurality of target formats).

Regarding claim 30, which is dependent on claim 20, Grobber discloses identifying tokens disposed within the source file, and associating the tokens with the feature list ([0065]: the token "Boston" disposed in the source file is identified and associated with the tags <TH> and </TH> among the other table tags).

Regarding claim 31, which is dependent on claim 20, Grobber discloses using a source file generator to initiate translation by the translator ([0080]).

Regarding claim 32, which is dependent on claim 20, Grobber discloses using a target file adapter module to perform secondary translation ([0080],[0085]).

Regarding claim 33, which is dependent on claim 32, Grobber discloses the target file adapter module translates the target file into another target format ([0080]-[0086]).

Regarding independent claim 34, Grobber discloses:

Art Unit: 2178

- providing a feature identifier to determine a feature set of the source file ([0062]-[0067], [0018]-[0021]: determine the tags of a table in the source file where said tags, which is a set of tags, represent the table feature)
- providing a buffer to store and analyze the feature set (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- providing a buffer to assemble the feature set ([0067]-[0069], [0071]: analyzing the tags in the source table data which is temporarily stored and selecting only tags suitable for creating a target table to import to the target file imply that there is a buffer where the source table data temporarily stored is provided for assembling the tags, which are the feature set, for creating the target table)
- providing a feature writer to write the feature set into the target file in the target format (figure 7, [0068]-[0073], [0021]: writing the source table into the target table in the target file by converting the source table tags into the target table tags)

Independent claim 35 is a system for method claim 34, and is rejected under the same rationale.

Independent claims 36 and 37 are an article of manufacture and a computer readable program code for method claim 34, and are rejected under the same rationale.

Art Unit: 2178

Claims 1-12, 15-18 are for a translator of method claims 20-33, and are rejected under the same rationale.

Regarding claims 13-14, Grobber discloses the translator comprises a user interface where the user interface comprises a GUI (figures 4-5).

Regarding claim 19, which is dependent on claim 1, Grobber discloses that the source and the target formats are selected from the group consisting of MIF, RTF, WordPerfect, VENTURA, Microsoft Word, Interleaf, HTML, SGML, XML, C, C++, Visual Basic, Pascal, Java, MFC, PowerPlant, Swing, SVG, HPJ, Flash, WMF, VRML, RenderMan, 3DMF, and combination thereof ([0080]).

Regarding independent claim 38, Grobber discloses a translator comprising:

- a feature identifier having a front-end lookup table to map code fragments of the source file to a list of features to determine a feature set of the source file ([0048]-[0052], [0062]-[0067], [0018]-[0021])
- a buffer to store and analyze the feature set (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- a buffer to assemble the feature set ([0067]-[0069], [0071]: analyzing the tags in the source table data which is temporarily stored and selecting only tags suitable

for creating a target table to import to the target file imply that there is a buffer where the source table data temporarily stored for assembling the tags, which are the feature set, for creating the target table)

- a feature writer having a back-end lookup table to map the feature set to HTML code fragments, to write the feature set into the target file in the HTML format (figure 7, [0068]-[0073], [0021], figures 4-5, [0050]-[0051])

Grobber does not disclose:

- the code fragments of the source file is the MIF code

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Grobber to include MIF into Grobber since Grobber discloses the format of the source file can be *any format* used by a database application, and the format of the target file can be in any tag language such as HTML or XML [0080]. This motivates to use MIF code as a format of the source file in exchanging the formats between the source documents and the target documents.

Responses to arguments

10. Applicants argue that Gemma is not properly combined with Grobler to disclose the feature "assembling the feature set in a buffer." Gemma is withdrawn from the

Art Unit: 2178

rejections. Grobler, in reconsideration, discloses the feature "assembling the feature set in a buffer." See the rejections above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gupta et al. (US 6,154,748). Gabler et al. (US 6,211,881).

Bscheider et al. (US 6,246,752). Kutay et al. (US 2002/00169789).

Konda et al. (US 2003/0041095). Balassanian (US 2005/0086348).

Sabadell et al. (US 2005/0144598). Hess et al. (US 2006/0206795)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
10/5/07